

## Edwards & Angell LLP

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Date : October 17, 2003

<u>From : John B. Alexander, Ph.D.</u>	<u>Fax : (617) 439-4170</u>	<u>Direct : (617) 517-5555</u>
<u>To : Group 1600</u>		
<u>U.S. Trademark &amp; Patent Office</u>	<u>Fax : (703) 872-9306</u>	<u>Direct :</u>

Pages : 14

(including cover sheet)

If you received a partial delivery, please call Michelle P. Chicos at (617) 517-5551.

Re :

Enclosed please find a Reply to Non-Compliant Amendment in connection with U.S. Serial No. 09/666,152.

Please do not hesitate to contact me if you have any questions, or if I can be of any further assistance at this time.

Best Regards,

John B. Alexander, Ph.D.

JBA:mpc

# Fax

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Received from < 617 439 4170 > at 10/17/03 2:37:54 PM [Eastern Daylight Time]

Practitioner's Docket No. 49218-C (71526)**PATENT****IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

APPLICANT: Shibuya et al.

SERIAL NO.: 09/666,152

EXAMINER: L. Stockton

FILED: September 20, 2000

GROUP: 1626

FOR: NOVEL AMIDE COMPOUNDS AND MEDICATIONS CONTAINING THE  
SAME

Mail Stop: No Fee Amendment

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

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OCT 20 2003

**AMENDMENT TRANSMITTAL**

1. Transmitted herewith is a Request for Reconsideration for this application.

**STATUS**

2. Applicant is  
☐ a small entity. A statement:  
☐ is attached.  
☐ was already filed.  
☒ other than a small entity.

**OFFICIAL****EXTENSION OF TERM**

NOTE: "Extension of Time in Patent Cases (Supplement Amendments) -- If a timely and complete response has been filed after a

**CERTIFICATE OF MAILING/TRANSMISSION (37 C.F.R. SECTION 1.8(a))**

I hereby certify that, on the date shown below, this correspondence is being:

**MAILING**

- ☐ deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to the Commissioner for Patents, Alexandria, VA 22313-1450.

**FACSIMILE**

- ☒ transmitted by facsimile to the Patent and Trademark Office (703) 872-9306.

Date: October 17, 2003

Signature

Michelle P. ChicosMichelle P. Chicos

(type or print name of person certifying)

(Amendment Transmittal--page 1 of 4)

*Non-Final Office Action, an extension of time is not required to permit filing and/or entry of an additional amendment after expiration of the shortened statutory period.*

*If a timely response has been filed after a Final Office Action, an extension of time is required to permit filing and/or entry of a Notice of Appeal or filing and/or entry of an additional amendment after expiration of the shortened statutory period unless the timely-filed response placed the application in condition for allowance. Of course, if a Notice of Appeal has been filed within the shortened statutory period, the period has ceased to run." Notice of December 10, 1985 (1061 O.G. 34-35).*

**NOTE:** See 37 C.F.R. Section 1.645 for extensions of time in interference proceedings, and 37 C.F.R. Section 1.550(c) for extensions of time in reexamination proceedings.

3. The proceedings herein are for a patent application and the provisions of 37 C.F.R. Section 1.136 apply.

*(complete (a) or (b), as applicable)*

- (a) ☐ Applicant petitions for an extension of time under 37 C.F.R. Section 1.136 (fees: 37 C.F.R. Section 1.17(a)(1)-(4)) for the total number of months checked below:

	Extension (months)	Fee for other than small entity	Fee for small entity
<input type="checkbox"/>	one month	\$ 110.00	\$ 55.00
<input type="checkbox"/>	two months	\$ 400.00	\$ 200.00
<input type="checkbox"/>	three months	\$ 920.00	\$ 460.00
<input type="checkbox"/>	four months	\$ 1,440.00	\$ 720.00

Fee: \$ 0.00

If an additional extension of time is required, please consider this a petition therefor.

*(check and complete the next item, if applicable)*

- ☐ An extension for \_\_\_\_\_ months has already been secured. The fee paid therefor of \$ \_\_\_\_\_ is deducted from the total fee due for the total months of extension now requested.

Extension fee due with this request \$ 0.00

OR

- (b) ☒ Applicant believes that no extension of term is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition for extension of time.

(Amendment Transmittal—page 2 of 4)

### FEE FOR CLAIMS

4. The fee for claims (37 C.F.R. Section 1.16(b)-(d)) has been calculated as shown below

(Col.1)	(Col. 2)	SMALL ENTITY			OR	OTHER THAN A SMALL ENTITY	
Claims Remaining After Amendment	Highest No. Previously Paid For	Present Extra	Rate	Addit. Fee		Rate	Addit. Fee
			<b>\$9.00</b>	<b>\$0.00</b>		<b>\$18.00</b>	
Independent Claims			<b>\$42.00</b>	<b>\$0.00</b>		<b>\$84.00</b>	
First Presentation of Multiple Dependent Claim+			<b>\$140.00</b>	<b>\$0.00</b>		<b>\$280.00</b>	
						<b>Total Addit. Fee</b>	

\* If the entry in Col. 1 is less than the entry in Col. 2, write "0" in Col. 3.

\*\* If the "Highest No. Previously Paid For" IN THIS SPACE is less than 20, enter "20".

\*\*\* If the "Highest No. Previously Paid For" IN THIS SPACE is less than 3, enter "3".

The "Highest No. Previously Paid For" (Total or Indep.) is the highest number found in the appropriate box in Col. 1 of a prior amendment or the number of claims originally filed.

**WARNING:** *"After final rejection or action (Section 1.113) amendments may be made canceling claims or complying with any requirement of form which has been made." 37 C.F.R. Section 1.116(a) (emphasis added).*

*(complete (c) or (d), as applicable)*

(c) ☐ No additional fee for claims is required.

**OR**

(d) ☐ Total additional fee for claims required \$ \_\_\_\_\_.

### FEE PAYMENT

5. ☐ Attached is a check in the sum of \$ 0.00  
☐ Charge Account No. \_\_\_\_\_ the sum of \$ \_\_\_\_\_  
 A duplicate of this transmittal is attached.

(Amendment Transmittal--page 3 of 4)

**FEE DEFICIENCY**

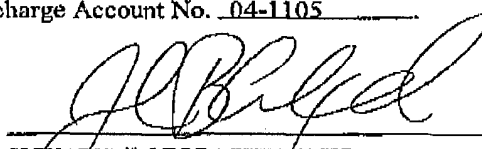
**NOTE:** *If there is a fee deficiency and there is no authorization to charge an account, additional fees are necessary to cover the additional time consumed in making up the original deficiency. If the maximum, six-month period has expired before the deficiency is noted and corrected, the application is held abandoned. In those instances where authorization to charge is included, processing delays are encountered in returning the papers to the PTO Finance Branch in order to apply these charges prior to action on the cases. Authorization to charge the deposit account for any fee deficiency should be checked. See the Notice of April 7, 1986, (1065 O.G. 31-33).*

6. ☒ If any additional extension and/or fee is required, charge Account No. 04-1105.

**AND/OR**

- ☒ If any additional fee for claims is required, charge Account No. 04-1105

Date: October 17, 2003

  
SIGNATURE OF PRACTITIONER

John B. Alexander, Ph.D. (Reg. No. 48,399)  
(type or print name of practitioner)

EDWARDS & ANGELL, LLP  
Dike, Bronstein, Roberts & Cushman  
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(Amendment Transmittal--page 4 of 4)

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Docket No. 49218-C (71526)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

**APPLICANT:** Shibuya et al.

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THE SAME

Mail Stop: Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

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REPLY TO NOTICE OF NON-COMPLIANT AMENDMENT

Sir:

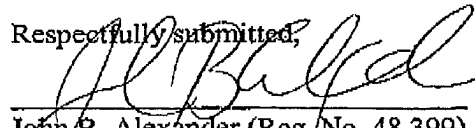
Applicants are in receipt of the Notice of Non-Compliant Amendment dated October 16, 2003. Enclosed is the entire "Amendments to the claims" section of the Amendment filed September 16, 2003 together with a Request for Continued Examination, in which the status of cancelled claims 1-8 was inadvertently omitted. The attached Amendments to the claims section properly lists claims 1-8 as cancelled.

Applicants believe that the prior response was a *bona fide* attempt to reply to the office action and further believe that the submission of the RCE together with the September 16, 2003 amendment removes the finality of the last action.

Although it is not believed that any additional fees are needed to consider this submission, the Examiner is hereby authorized to charge our deposit account no. 04-1105 should any fee be deemed necessary.

Date: October 17, 2003

Respectfully submitted,

  
John B. Alexander (Reg. No. 48,399)  
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Boston, MA 02209  
Tel: (617) 439-4444  
Fax: (617) 439-4170 / 7748